

REMARKS

This paper is submitted in response to the pending final Office Action mailed on August 24, 2007. Because this Response is electronically submitted with a Petition for a two month Extension of Time, a check for \$460.00 set forth under 37 C.F.R. §1.17(a)(2) and a certificate of electronic filing in compliance with 37 C.F.R. §1.8 on or before the shortened period for reply set to expire on **January 24, 2008**, this Response is timely filed.

Moreover, this Response is submitted contemporaneously with a Request for Continued Examination (RCE) under 37 C.F.R. §1.114, and a check in the amount of \$810.00 for the RCE fee set forth under 37 C.F.R. §1.17(e).

I. STATUS OF THE CLAIMS

Prior to this Response, claims 1 and 3 to 7 were pending and at issue. By this Response, claims 1, 3 to 7 have been amended in an attempt to clarify elements inherent in the originally filed claims. While Applicants believe that no additional fees are due in connection with this application, Applicants direct the Office to charge **Deposit Account No. 23-1925 (09683-00164)** for any fees deemed owed during the pendency of this application, excluding the issue fee.

II. CLAIM OBJECTION

The Office Action objects to claim 3 for containing an informality. Applicants respectfully traverse the pending objection in light of the amendment to claim 3. Thus, Applicants respectfully request withdrawal and reconsideration of the pending objection.

III. CLAIM REJECTIONS

The Office Action rejects: claim 6 under 35 U.S.C. §112, first paragraph; claims 4 to 6 under 35 U.S.C. §102(e) as anticipated by U.S. Published Patent Application No. 2005/0119000 to Nasielski et al. ("*Nasielski*"); and claims 1, 3 and 7 under 35 U.S.C. §103(a) as unpatentable over *Nasielski* in view of U.S. Published Patent Application No. 2003/0013458 to Yabe et al. ("*Yabe*").

A. REJECTION UNDER 35 U.S.C. §112

Applicants respectfully traverse the rejection of claim 6 as allegedly failing to comply with the written description requirement set forth under 35 U.S.C. §112, first paragraph. Applicants submit that the pending rejection has been rendered moot in light of the amendments to claim 6. Applicants further request entrance and consideration of these amendments as they are submitted in light of the new rejections set forth in this final Office Action.

B. REJECTIONS UNDER 35 U.S.C. §102

Applicants respectfully traverse the rejection of claims 4 to 6 as anticipated by *Nasielski*. In particular, *Nasielski* does not disclose an invention identical to the claimed systems and device, nor does it recite or teach each and every element set forth in the claims 4 to 6. For example, independent claim 4 recites, in relevant part, a contents server configured to be connected to a home mobile communication network for providing to a mobile unit of a user under a contractual agreement with said home mobile communication network a roaming service via a foreign mobile communication network, the contents server including contents transmission means for receiving a data signal transmitted from a mobile unit via said home mobile communication network, wherein said contents include accessible contents that are transmittable via the home mobile communication network and the foreign mobile communication network, and non-accessible contents transmittable via the home mobile communication network, and transmitting contents to said mobile unit in response to a request contained in said data signal, and detection means for detecting whether a data signal received by said contents transmission means is attached with roaming identification information added to said data signal, said roaming identification information showing that said data signal is transmitted from said mobile unit in foreign mobile communication network to which said server is not connected and to which said mobile unit does not belong, and wherein said contents transmission means, when said detection means detects that said data signal is attached with said roaming identification information, is configured to transmit to said mobile unit which transmits said data signal a notification that requested contents cannot be transmitted. In other words, the configuration of the content server recited

in claims 4 to 6 prevents non-accessible content from being downloaded to a mobile unit in response to a request from a home mobile communication network to a foreign mobile communication network when the mobile unit is operating within the foreign mobile communication network.

Nasielski does not disclose or suggest such a communications system. *Nasielski* simply discloses a system in which a roaming mobile station operating within a foreign network may access services of the foreign network by providing or identifying a home network to which the roaming mobile station is associated to a centralized server. The centralized server, in turn, may be configured to allow the home network to which the roaming mobile station is associated to authorize access to the services of the foreign network. In this way, the system of *Nasielski* reduces the time required for a roaming mobile station to access services within the foreign network it is operating. However, the system of *Nasielski* is completely silent regarding restricting or controlling access to services provided by the home network when the roaming mobile station request said services via the foreign network. Thus, *Nasielski* discloses a system to speed-up or enable access to services rather than a system to restrict or control access by a roaming mobile unit to services between home and foreign networks. For at least these reasons, *Nasielski* does not disclose each and every element recited in the claims 4 to 6.

C. REJECTIONS UNDER 35 U.S.C. §103

Applicants respectfully traverse the rejection of claims 1, 3 and 7 as unpatentable over *Nasielski* in view of *Yabe*. In particular, the combination of *Nasielski* and *Yabe* does not disclose each and every element recited in the claims and thus cannot be the basis for establishing a *prima facie* case of obviousness. As discussed above in Section III-B, *Nasielski* does not disclose a system to restrict or control access by a roaming mobile unit to services between home and foreign networks much less a contents server for transmitting to a mobile unit contents via a home mobile communication network, or via a mobile communication network and a foreign mobile communication network wherein said contents include transmittable contents that are accessible via the home mobile communication network and the

foreign mobile communication network, and non-transmittable contents accessible via the home mobile communication network.

Yabe does not provide the disclosure or teaching missing from *Nasielski*. *Yabe* dimply discloses a relay center and an information retrieval method for searching information on a network by using location information of a mobile station. As discussed in previous Responses, *Yabe* is silent regarding the rejection means for determining presence of roaming identification information added to a data signal received from said mobile unit in said another mobile communication network, and for rejecting a request for content designated to not be transmitted to said mobile unit in said another mobile communication network, if the roaming identification information is determined to be present. Moreover, *Yabe* does not disclose or even suggest a contents server for transmitting to a mobile unit contents via a home mobile communication network, or via a mobile communication network and a foreign mobile communication network wherein said contents include transmittable contents that are accessible via the home mobile communication network and the foreign mobile communication network, and non-transmittable contents accessible via the home mobile communication network as recited by the claims at issue. Thus, as with *Nasielski*, *Yabe* does not disclose a system to restrict or control access by a roaming mobile unit to services between home and foreign networks.

For at least these reasons, Applicants submit that the combination of *Nasielski* and *Yabe* is insufficient to establish a *prima facie* case of obviousness. Thus claims 1, 3 and 7 are patentable over any combination or modification of *Nasielski* and *Yabe*.

IV. CONCLUSION

For the foregoing reasons, Applicant respectfully requests withdrawal of the pending rejections and submits that the above-identified patent application is now in condition for allowance and earnestly solicits reconsideration of same. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting prosecution of this application.

APPL. No. 10/761,663
RESP. DATED JANUARY 8, 2008
RESP. TO OFFICE ACTION OF AUGUST 24, 2007

ATTY. DOCKET No.: 09683-00164

Respectfully submitted,
BRINKS HOFER GILSON & LIONE

Dated: **January 8, 2008**

By: /Matthew T. Ridsdale/

Matthew T. Ridsdale
Reg. No. 56,832
Cust. No. **00757**
Direct: (312) 245-5311
mridsdale@usebrinks.com